

REMARKS

Claims 10 to 25 are now pending. In view of the following remarks, it is respectfully submitted that claims 10 to 25 are allowable, and reconsideration is respectfully requested.

Applicants note that the Office Action Summary does not acknowledge the claim for foreign priority and does not indicate whether the priority document has been received. Applicants note, however, that the Notification of Missing Requirements Under 35 U.S.C. § 371 mailed on March 19, 2002 indicates receipt of the priority document. Applicants respectfully request that the Examiner acknowledge in the next office action the claim for foreign priority and receipt of the priority document.

Claims 10 to 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,964,515 ("Ikeuchi") in view of U.S. Patent No. 5,050,045 ("Kato"). It is respectfully submitted that claims 10 to 25 are allowable for at least the following reasons.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must describe or suggest each claim feature, and there must be a motivation or suggestion to modify or combine the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). This motivation or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claim 10 reads as follows:

An illumination device for a display instrument, comprising:
a dial face;
a pointer scale arranged on the dial face;
a first scale marking of the pointer scale arranged on a first side of the pointer scale on the dial face;
at least one of a second scale marking of the pointer scale and an auxiliary scale arranged on a second side of the pointer scale on the dial face;
a first light source for illuminating the first scale marking;
an optical waveguide into which a light of the first light source is injected, the light being deflected from the optical waveguide to the second scale marking;

at least one second light source for illuminating the pointer scale; and
a light funnel arranged between the at least one second light source and the pointer scale, wherein:
a light path from the at least one second light source to the pointer scale is separated from the optical waveguide by the light funnel.

It is respectfully submitted that Ikeuchi and Kato do not disclose, or even suggest, the feature of a light funnel arranged between a pointer scale and at least one second light source for illuminating the pointer scale, such that a light path from the at least one second light source to the pointer is separated from an optical waveguide for illuminating scale markings of the pointer scale, as recited in claim 10. In this regard, the Office Action merely asserts that Ikeuchi discloses these features of claim 10 but provides no support or explanation for its assertions. The Ikeuchi reference only refers to illuminating the pointer devices with one lamp only, in which the light of this one lamp is coupled onto a wave guide and diffused (see col. 3, lines 1 to 27) and it does not disclose, or even suggest, that the path of the light from this lamp be separated from the light of a second lamp, let alone separated with a funnel.

Furthermore, there is no suggestion in Ikeuchi, or in Kato, that the two scale markings to be illuminated are arranged on different sides of the pointer scale so that the pointer scale and scale markings can be illuminated differently while the illumination of the pointer scale marking is nevertheless homogenous. Indeed, a separate illumination of the pointer scale and of the pointer scale markings via a first and second light source, as required by claim 1, is not even discussed by Ikeuchi and Kato.

For at least the foregoing reasons, the combination of Ikeuchi and Kato fails to disclose, or even suggest, all of the features of claim 10. Accordingly, even if it were proper to combine the Ikeuchi and Kato references as suggested (which is not conceded, as explained below in further detail), it is respectfully submitted that such combination does not render unpatentable claim 10, or claims 18 and 20, which claims include analogous features, like those of claim 10 or of any of the dependent claims 11 to 17, 19 and 21 to 25.

It is also respectfully submitted that the Office Action's asserted suggestion to combine the Ikeuchi and Kato references is plainly based on nothing more than hindsight reasoning. In this regard, in rejecting a claim under 35 U.S.C. § 103, Applicant's invention

“must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.” Indeed, the Office Action does not even assert that it would have been obvious at the time the invention was made to make such a combination. Accordingly, combining these prior art references without evidence of a proper suggestion, teaching, or motivation “simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability — the essence of hindsight.” In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Moreover still, it is respectfully submitted that a *prima facie* case of obviousness has not been made in the present case, since the Office Action never made any findings, such as, for example, regarding what the ordinary skill level in the art would have been at the time the claimed subject matter of the present application was made. (See In re Rouffet, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art,” and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone.” (See In re Kotzab, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing In re Dembiczak, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art,” the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is again respectfully submitted that there has been no such showing by the Office Action.

In fact, it is respectfully submitted that the lack of any of the required factual findings in the Office Action forces Applicants to resort to unwarranted speculation to ascertain exactly what facts underlie the present rejections. The law requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Office has failed to carry the initial burden of presenting a proper *prima facie* case of obviousness. (See In re Oetiker, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

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In view of the foregoing, it is respectfully submitted that claims 10 to 25 are allowable over the references relied upon, whether taken individually, combined or modified. It is respectfully requested that the obviousness rejections of claims 10 to 25 be withdrawn.

CONCLUSION

In view of all of the above, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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